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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,845	08/06/2003	Hiraku Murayama	011350-316	6514

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BUCHANAN, INGERSOLL & ROONEY PC  
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EXAMINER
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HOEKSTRA, JEFFREY GERBEN

ART UNIT	PAPER NUMBER
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3736

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/22/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/634,845	Applicant(s) MURAYAMA ET AL.	
	Examiner Jeffrey G. Hoekstra	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-15 and 17-35 is/are pending in the application.
- 4a) Of the above claim(s) 2, 5, 6 and 32-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 7-15 and 17-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Notice of Amendment*

1. In response to the amendment filed on 09/25/2006, amended claim(s) 1, 3, 9, 11, 12, 13, 19, 21, 22, 23, and 26, canceled claim(s) 4 and 16, and new claim(s) 30-35 is/are acknowledged. The current rejections of the claim(s) 1, 3, 4, and 7-29 is/are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

### *Election/Restrictions*

2. Applicant's election of Group 1, drawn to claims 1, 3, 7-31, in the reply filed on 12/22/2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. Claims 32-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/22/2006.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Specification***

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, 7-10, 12-13, 17-20, 22-24, 26-28, and 30-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Uchino et al (US 5,769,796) as broadly as *structurally* claimed.

8. For claims 1, 3, 9, 10, and 26, Uchino et al discloses a guidewire member (51), comprising:

- a first distal wire member (61) having a proximal end face butt resistance welded to a second proximal wire member (62) having a distal end face, wherein said first distal wire's proximal end face is butt resistance welded to said second proximal wire's distal end face (as best seen in Figure 3(3) and column 8 lines 16-19) without axial overlap of said first and second wires, creating a welded portion;

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- a cover layer (63) provided on the outer periphery that uniformly covers said welded portion (as best seen in Figure 9), wherein said cover layer can be made of a metal with an elastic modulus that is less than that of said first wire (column 3 line 37 – column 4 line 65) or a silicon resin (column 6 lines 19-65); and
- a distal-side cover layer (67) disposed distally from said cover layer (as best seen in Figure 9), made from a different material (column 12 lines 4-46), and not overlapping said cover layer (as best seen in Figure 9).

9. For claims 7-10, 12-13, 17-20, 22-23, and 27-28, Uchino et al discloses said cover layer and said distal-side cover layer being hydrophilic and reducing friction (column 12 lines 47-56).

10. For claims 14, 24, 30 and 31, Uchino et al discloses a composite guidewire comprising different wire materials including: said distal wire being a superelastic alloy wires and said proximal wire being stainless steel (column 3 line 37 – column 4 line 65).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 11, 21, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchino et al. Uchino et al discloses the claimed invention but does not disclose expressly the thickness of the cover layer and distal-side cover layer being 1 micron. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the guidewire as taught by Uchino et al with the thickness of the cover layer and distal-side cover layer being 1 micron, because Applicant has not disclosed that Uchino et al provides an advantage, is used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the thickness of the metallic layer (column 12 lines 24-25) as taught by Uchino et al, because it provides for connecting unlike materials when configuring a guidewire with varying mechanical properties and since it appears to be an arbitrary design consideration which fails to patentably distinguish over Uchino et al. Therefore, it would have been an obvious matter of design choice to modify Uchino et al to obtain the invention as specified in the claim(s).

14. Claims 15 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchino et al in view of Reynolds et al (US 2003/0069521 A1). Uchino et al discloses the claimed guidewire as aforementioned except for explicitly disclosing the

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use of Co-Ni-Cr based alloy wire. Reynolds et al teaches the use of cobalt-based alloys in guidewire construction (paragraph 33). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the composite guidewire as taught by Uchino et al, with the Co-Ni-Cr based alloy wire as taught by Reynolds et al for the purpose of coupling wires having varying mechanical properties to configure the guidewire for traversing tortuous vasculature.

### ***Response to Arguments***

15. Applicant's arguments with respect to claims 1, 3, 7-15, and 17-31 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571) 272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JH JH 1/10/07

*M. J. H. H. H.*  
[Faint stamp]